UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,841	08/30/2001	Christian Mayaud	58511-020	6708

			EXAMINER
20822	7590	10/18/2005	KOPPIKAR, VIVEK D

RUDEN, MCCLOSKY, SMITH, SCHUSTER & RUSSELL, P.A.
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ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *30 August 2001*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *70-115* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *70-115* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *8/30/01* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date *9/20/01 & 4/24/02*.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

EA

DETAILED ACTION

Status of the Application

1.   Claims 70-115 have been examined in this application. The Information

Disclosure (IDS) statement filed on September 20, 2001 has also been acknowledged.

This application is a continuation application of applications with the serial numbers

09/121,596, 08/942,372 and 08/330,745.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 70-77, 81-82, 84-86, 91-100, 102-107, 111-113 and 115 rejected under 35

U.S.C. 102(a) as being unpatentable by US Patent Number 5, 390, 238 to Kirk.

(A)   As per claim 70, Kirk teaches a computerized prescription system (Kirk:

Abstract):

at least one user computer, said user computer having a graphical user interface

facilitating fulfillment of electronic prescription information and providing access to one

or more of (1) information about a patient's prescription history, (2) information about

pharmaceuticals arranged by medical conditions for which the pharmaceuticals are

suitable for treating, and (3) information about the properties of pharmaceuticals (Figure

2; Col. 1, Ln. 50-Col. 2, Ln. 3; and Col. 3, Ln. 20-42).

(B)   As per claim 71, in Kirk the user computer is connected to a communications medium by which said user computer may communicate with one or more other computers (Figure 5 and Col. 4, Ln. 34-46).

(C)   As per claim 72, in Kirk one or more computers includes at least one computer run by or on behalf of at least one of (1) a Health Maintenance Organization, (2) a hospital, (3) an insurance company, (4) a drug benefit plan, (5) a pharmacy, (6) a laboratory, and (7) a physician practice (Col. 3, Ln. 20-42).

(D)   As per claim 73, in Kirk the user computer is configured to gather information from more than one of said one or more computers and presents that information to a user upon request submitted through said graphical user interface (Figure 4; Col. 3, Ln. 23-24 and Col. 4, Ln. 47-Col. 5, Ln. 6)

(E)   As per claim 74, in Kirk the user computer is configured to gather information from more than one of said one or more computers and compile that information into a prescription history for a patient (Figure 1; Col. 3, Ln. 23-24; Col. 3, Ln. 43-Col. 4, Ln. 7 and Col. 5, Ln. 55-Col. 6, Ln. 5)

(F)   As per claim 75, in Kirk the user computer is configured to gather information from more than one of said one or more computers and compile that information into said information about pharmaceuticals (Figure 1 and Col. 4, Ln. 46-Col. 5, Ln. 5).

(G)   As per claim 76, in Kirk the user computer is configured to gather information from more than one of said one or more computers and compile that information into said information about the properties of pharmaceuticals (Col. 4, Ln. 46-68)

(H)   As per claim 77, in Kirk the graphical user interface permits a user to receive a

prescription directly from a point of care provider over said communications medium

(Figures 1 and 4; Col. 2, Ln. 35-42 and Col. 5, Ln. 55-Col. 6, Ln. 5)

(I)   As per claim 81, in Kirk when a pharmaceutical is prescribed for a condition, and

the pharmaceutical is not the best first line agent for treatment of that condition, the

graphical user interface will suggest an alternative pharmaceutical to be prescribed

instead (Col. 5, Ln. 28-32).

(J)   As per claim 82, in Kirk the guidelines relating to the use of said alternative

pharmaceutical may be retrieved using said graphical user interface (Col. 5, Ln. 28-32).

(K)   As per claim 84, Kirk teaches a computer implemented method of facilitating

fulfillment of a prescription, comprising the steps of

        a. displaying prescription information using a computer interface; said

prescription information having been formatted for communications (Col. 4, Ln. 47-Col.

5, Ln. 21); and

        c. receiving said prescription information at a pharmacy over a communications

link to be filled (Figure 2 and Col. 3, Ln. 20-42).

(L)   As per claim 85, in Kirk the prescription information includes the condition to be

treated by the prescribed item (Col. 4, Ln. 46-68).

(M)   As per claim 86, in Kirk the prescription information is selected from a predefined

list (Col. 3, Ln. 38-42).

(N)   As per claim 91, Kirk teaches a computerized prescription system (Kirk:

Abstract), comprising:

at least one user computer, said user computer having a graphical user interface permitting display of prescription information received from a prescriber and providing access to one or more of (1) information about a patient's medical history, (2) information about therapeutic agents and (3) information about individual prescriber activity (Figures 1-2; Col. 1, Ln. 50-Col. 2, Ln. 3; and Col. 3, Ln. 20-42).

(O)   As per claim 92, in Kirk information an individual prescriber is stored on said user computer and also on another computer (Figures 1 and 5; Col. 4, Ln. 34-46; Col. 5, Ln. 55-Col. 6, Ln. 5).

(P)   As per claim 93, in Kirk information about a patient's medical history includes identification of one or more prescriptions and an identification (verification) of a person who prescribed said one or more prescriptions (Figures 1 and 4 and Col. 4, Ln. 47-61).

(Q)   As per claim 94, Kirk teaches that the identification of a person who prescribed one or more prescriptions includes identification of how to contact (telephone numbers) the person who prescribed one or more prescriptions (Figures 1-5; Col. 3, Ln. 20-42 and Col. 5, Ln. 21-27).

(R)   As per claim 95, in Kirk the graphical user interface includes providing suggestions to a provider (deviations from prescribed schedules) if dosages do not reflect said patient's medical history (Figures 1 and 3-4; Col. 5, Ln. 40-Col. 6, Ln. 5).

(S)   As per claim 96, Kirk teaches a computer program product, comprising (Kirk: Abstract):

a. a memory medium (Col. 3, Ln. 43-61); and

b. a computer program stored on said memory medium, said computer program containing instructions for capturing prescription information and providing access to one

or more of (1) information about a patient's prescription history, (2) information about

pharmaceuticals arranged by medical conditions for which the pharmaceuticals are

suitable for treating, and (3) information about the properties of pharmaceuticals. (Col. 3,

Ln. 20-42 and Col. 4, Ln. 46-68).

(T)   As per claim 97, Kirk teaches a computer program product (Kirk: Abstract),

comprising:

a. a memory medium (Col. 3, Ln. 43-61); and

b. a computer program stored on said memory medium, said computer program

containing instructions for displaying prescription information which has been formatted

for communications using a computer interface, and for receiving said prescription

information at a pharmacy over a communications link to be filled (Figures 1 and 4; Col.

3, Ln. 20-42 and Col. 4, Ln. 8-68)

(U)   As per claim 98, Kirk teaches a computer program product (Kirk: Abstract),

comprising:

a. a memory medium (Col. 3, Ln. 41-63) ; and

b. a computer program stored on said memory medium, said computer program

containing instructions for interrogating databases expected to contain information about

a patient based on a patient's relationship with the provider of that database and for

assembling patient information into a chronologically current version of said patient's

prescription history (Figures 1 and 4; Col. 3, Ln. 20-42 and Col. 4, Ln. 46-68)

(V)   As per claim 99, Kirk teaches a computer program product (Kirk: Abstract),

comprising:

a. a memory medium (Col. 3, Ln. 43-61); and

b. a computer program stored on said memory medium, said computer program

containing instructions for implementing a graphical user interface permitting display of

prescription information and permitting access to one or more of (1) information about a

patient's medical history, (2) information about therapeutic agents and (3) information

about individual prescriber activity (Figures 1 and 4; Col. 3, Ln. 20-42 and Col. 4, Ln.

46-68).

(W)   As per claim 100, Kirk teaches a prescription fulfillment software system

implemented on a computer comprising a program embodied on a computer-readable

medium, the system being for use by pharmacy personnel to fill an electronic prescription

prescribing a drug treatment for a patient condition exhibited by a patient, the patient

having a drugs benefit provider, the drugs benefit provider issuing a prescription benefit

plan including a drug formulary for the patient listing at least one drug preferred by the

drugs benefit provider for treatment of the condition, the electronic prescription

comprising a patient identifier, at least one prescribed drug and at least one drug

quantifier for the prescribed drug (Col. 3, Ln. 20-61 and Col. 4, Ln. 46-68), the

prescription fulfillment system providing:

a)   a prescription screen display (Figures 1 and 3-4 and Col. 3, Ln. 20-61),

displaying:

i)   patient-identifying data (Col. 3, Ln. 48-51);

ii)   prescribed drug identification data (Col. 4, Ln. 46-68);

iii)   drug quantification data (Col. 4, Ln. 59-61); and

b)   drug formulary information identifying at least one of multiple drugs as a patient's

drug benefit provider's drug formulary preferences to ensure that the electronic

prescriptions is filled with a benefit plan recommended drug (Col. 3, Ln. 20-42; Col. 4,

Ln. 59-61 and Col. 5, Ln. 28-32)

(X)   As per claim 102, Kirk teaches a computerized prescription system (Kirk:

Abstract), comprising:

at least one user computer, said user computer having a graphical user interface

permitting capture of prescription information and providing access to all of (1)

information about a patient's prescription history, (2) information about pharmaceuticals

arranged by medical conditions for which the pharmaceuticals are suitable for treating,

and (3) information about the properties of pharmaceuticals, wherein said user computer

is connected to a communication medium by which said user computer communicates

with one or more other computers run respectively by or on behalf of one or more of a

group consisting of (a) a Health Maintenance Organization, (b) an insurance company,

(c) a drug benefit plan, (d) a pharmacy run by a different organization than the

organization running the user computer, (e) a laboratory, and (f) a physician practice

(Figures 1, 3-4; Col. 3, Ln. 20-42 and Col. 4, Ln. 46-68)

(Y)   As per claim 103, in Kirk the user computer is configured to gather information

from more than one of said one or more computers and presents that information to a user

upon request submitted through said graphical user interface (Col. 3, Ln. 20-61 and Col.

4, Ln. 46-68)

(Z)   As per claim 104, in Kirk in which the user computer is configured to gather

information from more than one of said one or more computers and compile that

information into a prescription history for a patient (Col. 3, Ln. 20-61 and Col. 4, Ln. 27-

68).

(A1)   As per claim 105, in Kirk the user computer is configured to gather information from more than one of said one or more computers and compile that information into said information about pharmaceuticals (Col. 4, Ln. 46-68)

(B1)   As per claim 106, in Kirk the user computer is configured to gather information from more than one of said one or more computers and compile that information into said information about the properties of pharmaceuticals (Col. 4, Ln. 46-68)

(C1)   As per claim 107, in Kirk the graphical user interface permits a user to send a prescription directly to a pharmacy to be filled over said communications medium (Figures 1 and 3-4 and Col. 2, Ln. 55- Col. 3, Ln. 12).

(D1)   As per claim 111, in Kirk when a pharmaceutical is prescribed for a condition, and the pharmaceutical is not the best first line agent for treatment of that condition, the graphical user interface will suggest an alternative pharmaceutical to be prescribed instead (Col. 5,Ln. 28-32).

(E1)   As per claim 112, in Kirk the guidelines relating to the use of said alternative pharmaceuticals may be retrieved using the graphical user interface (Figures 1 and Col. 5, Ln. 22-32).

(F1)   As per claim 115, Kirk teaches a computerized prescription system (Kirk: Abstract), comprising:

at least one user computer, said user computer having a graphical user interface permitting capture of prescription information and providing access to all of (1) information about a patient's medical history, (2) information about therapeutic agents and (3) information about individual prescriber activity, wherein the information is

obtained from only databases located remotely from the location of the said user

computer (Figure 2; Col. 1, Ln. 50-Col. 2, Ln. 34; Col. 3, Ln. 20-42).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 78-80, 83, 87-90, 108-110 and 113 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Kirk, as applied to Claims 70, 84, 102, above in view of US

Patent Number 5,774,879 to Custy.

(A)   Claims 78-80, 83, 87-90, 108-110 and 113 are directed towards customized

methods of arranging and sorting data. This feature is not taught in Kirk, however, it is

well known in the art as evidenced by Custy (Col. 15, Ln. 38-53). At the time of the

invention it would have been obvious for one of ordinary skill in the art to have modified

the health support system of Kirk with the customized data arranging and sorting feature

as taught in Custy with the motivation of providing the user with a means of producing

customized reports or modifying existing reports, as recited in Custy (Col. 39-41).

6.   Claim 101 is rejected as being unpatentable over Kirk in view of US Patent

Number 5,642,731 to Kehr.

(A)   As per claim 101, Kirk teaches a prescription fulfillment software system

implemented on a computer comprising a program embodied on a computer-readable

medium, the system being for use by pharmacy personnel to fill an electronic prescription

prescribing a drug treatment for a patient condition exhibited by a patient, the patient

having a drugs benefit provider, the drugs benefit provider issuing a prescription benefit

plan including a drug formulary for the patient listing at least one drug preferred by the

drugs benefit provider for treatment of the condition, the electronic prescription

comprising a patient identifier, at least one prescribed drug and at least one drug

quantifier for the prescribed drug (Col. 3, Ln. 20-61 and Col. 4, Ln. 46-68), the

prescription fulfillment system providing:

a)   a prescription screen display (Figures 1 and 3-4 and Col. 3, Ln. 20-61),

displaying:

i)   patient-identifying data (Col. 3, Ln. 48-51);

ii)   prescribed drug identification data (Col. 4, Ln. 46-68);

iii)   drug quantification data (Col. 4, Ln. 59-61); and

b)   drug formulary information identifying at least one of multiple drugs as a patient's

drug benefit provider's drug formulary preferences to ensure that the electronic

prescriptions is filled with a benefit plan recommended drug (Col. 3, Ln. 20-42; Col. 4,

Ln. 59-61 and Col. 5, Ln. 28-32).

Kirk does not teach a drug contraindication review routine automatically

activatable from the prescription fulfillment system prior to fulfillment, the drug

contraindication review routine accessing contraindication information regarding the

prescribed drug and generating an alert regarding a relevant such contraindication. The

aforementioned feature, although not present in Kirk, is nevertheless well known in the

art as evidenced by Kehr (Col. 6, Ln. 65-Col. 7, Ln. 13). At the time of the invention it

would have been obvious to one of ordinary skill in the art to have modified the health

support system of Kirk with the aforementioned feature from Kehr which warns of drug

contraindication with the motivation of providing a means of warning a patient regarding

potential drug interactions, as recited in Kehr (Col. 7, Ln. 5-10).

7.   Claim 114 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk as

applied to Claim 102.

In Kirk the user computer is not a personal digital assistant. However Kirk does

suggest that a portable computer can be used as part of the health support system (Figure

3). Furthermore, the examiner takes Official Notice with respect to using a personal

digital assistant as a user computer. At the time of the invention it would have been

obvious for one of ordinary skill in the art to have used a personal digital assistant as a

user computer with the motivation of having an easily transportable and portable means

of accessing the health support system taught by Kirk.

Conclusion

8.   Any inquire concerning this communication or earlier communications from the

examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-

5109. The examiner can normally be reached from Monday to Friday between 8 AM and

4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's

supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone

number for this group is (703) 305-7687 (for official communications including After

Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application

Information Retrieval (PAIR). Information regarding the status of an application can be

obtained from the (PAIR) system. Status information for published applications may be
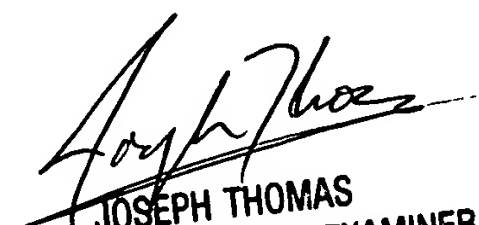
obtained from either Private PAIR or Public PAX. Status information for unpublished

applications is available through Private PAIR only. For more information about the

PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the

Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at

866-217-9197 (toll-free).

Sincerely,

Vivek Koppikar

10/7/2005

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
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